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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,552	11/08/2001	John Ruckart	36968/262396 (BS 001252)	6895

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EXAMINER	
RHODE JR, ROBERT E	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/007,552	RUCKART, JOHN	
	Examiner	Art Unit	
	Rob Rhode	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2, 5 - 12* is/are pending in the application.

4a) Of the above claim(s) *13-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2, 5 - 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 March 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant amendment of 4-7-05 amended claims 1, 5 and 22 and canceled claims 3 and 4 and withdrew claims 13 - 22 as well as traversed rejections of Claims 1 - 22.

Currently, claims 1, 2 and 5 - 12 are pending.

Claim Rejections - 35 USC § 101

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In Claims 1 - 7, the claimed invention is directed to non-statutory subject matter. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within

a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the body of the claim as recited can be completed with a accessing a counter top catalog of products and pencil and paper to calculate the offering price, which includes a progressive discount amount.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 7 - 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubin (US 6,078,897) in view of Carter (US 2002/0071526 A1).

Regarding claim 1 and related claim 8, Rubin teaches a method and computer readable medium for conveying sales options comprising:

offering a plurality of telecommunications related products to a customer; receiving a selection from the customer; determining an offering price for the selection, employing a progressive discount; accessing a predetermined pricing table having a product number, a product base price and a discount rate to determine a product price wherein the selection comprises at least one product (see at least Col 3, lines 25 – 58); and presenting said offering price to said customer (see at least Abstract, Col 2, lines 24 – 33 and Figures 2 and 3).

Please note, Rubin does not specifically disclose telecommunications related products. However, Rubin does disclose products. Moreover, the type or kind of products such as telecommunications is considered non-functional descriptive material and thereby is given little patentable weight. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from Rubin. Thereby, the non-fictional descriptive material is directed only to the kind/type of product (. i.e. telecommunications - which is stored data) and therefore does not affect either the structure or method/process of Rubin, which leaves the method and system unchanged.

While Rubin does disclose a pricing table/catalog and calculating a discount price, the reference does not specifically disclose a method summing the product prices employing a formula of OP= offering price; I = product number; Si = is a switch value of 1 if the ith product is selected, and value of the ith product is not selected; Pi = the base

price of the ith product; and Aj = the discount rate, where j represents the number of selected products.

On the other hand, Carter does disclose a formula, which produces the same results (see at least Col 2, lines 41 – 52). Please note that this formula used to calculate a discount is well known. For example, the offering price of a specific product in the catalogue of Rubin and the pricing tables of Carter produces the same *results* as the instant applicant's formula. For example, in determining an offering price in a progressive discount, the offering price is summation of the number of products at some point Si, which will trigger a discount for the order at this step/point/quantity. Thereby, the formula is considered simply to be a volume discount, which triggers the discount and applies it automatically to the customer's order and is disclosed in Carter.

It would have been obvious to one of ordinary skill to have provided the method of Rubin with the method of Cater to produce the same results as recited in claim 1. Rubin discloses a method a method and computer readable medium for conveying sales options comprising: offering a plurality of telecommunications related products to a customer; receiving a selection from the customer; determining an offering price for the selection, employing a progressive discount; accessing a predetermined pricing table having a product number, a product base price and a discount rate to determine a product price wherein the selection comprises at least one product; and presenting said offering price to said customer (see at least Abstract, Col 2, lines 24 – 33 and Figures 2

and 3). In turn, Carter discloses a formula for calculating a volume discount at point greater than one and is trigger by the customer purchasing in volume. Therefore, one of ordinary skill in the art would have been motivated to extend Rubin with discloses a formula for calculating a volume discount at point greater than one and is trigger by the customer purchasing in volume. Thereby, the customers discounts will be same for all and not cause variations of prices, which can lead to confusion and customer dissatisfaction

Regarding claim 2 and related claim 9, Rubin teaches a method, wherein said progressive discount comprises: providing a greater discount upon selection of at least one of a greater number and a higher level of products (see at least Col 2, lines 24 – 33).

Regarding claim 7 and related claim 12, Rubin teaches a method, further comprising: providing an opportunity for said customer to change said selection; if customer changes said selection, receiving customer's changed selection; determining an offering price for customer's changed selection; and presenting said offering price to said customer (see at least Col 9, lines 1 – 12).

Claims 5, 6, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rubin (US 6,078,897) and Cater (US

5,878,400) as applied to claims 1 and 8, and further in view of Israelski (US 2002/0071526 A1).

The combination of Rubin and Carter substantially discloses and teaches the applicant's invention.

However, combination does not specifically disclose and teach a method and computer medium, further comprising: receiving information about customer usage of said plurality of products; and recommending products based on received information about customer usage and further comprising: providing to said customer, an incremental offering price of an upgrade to said customer's selection.

On the other hand and regarding claim 5 and related claim 10, Israelski teaches a method and computer medium, further comprising: receiving information about customer usage of said plurality of products; and recommending products based on received information about customer usage (see at least Abstract and Para 0010).

Regarding claim 6 and related claim 11, Israelski teaches a method, further comprising: providing to said customer, an incremental offering price of an upgrade to said customer's selection (see at least Para 0029).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Rubin and Cater with the method and computer medium of Israelski to have enabled a method and computer medium further comprising: receiving information about customer usage of said plurality of products; and recommending products based on received information about customer usage and further comprising: providing to said customer, an incremental offering price of an upgrade to said customer's selection – in order to provide upgrade choices to a customer based on usage. The combination of Rubin and Carter discloses the method recited in claim 1. Israelski discloses a method and computer medium, further comprising: receiving information about customer usage of said plurality of products; and recommending products based on received information about customer usage and further comprising: providing to said customer, an incremental offering price of an upgrade to said customer's selection. (Abstract and Para 0010). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Rubin and Cater with a method and computer medium for further comprising: receiving information about customer usage of said plurality of products; and recommending products based on received information about customer usage and further comprising: providing to said customer, an incremental offering price of an upgrade to said customer's selection. In this manner and with these additional features, the method and medium facilitate and ease the decision process for the customer, which will enhance the customer's ability to meet all requirements. In turn, the method and medium will benefit as well with the increased probability of additional sales.

Response to Arguments

Applicant's arguments, filed 4-7-05, with respect to the rejection(s)of claim(s) 1, 2 and 5 - 12 under 35 USC 103(a) have been fully considered and are persuasive regarding only Variables. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Carter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **571.272.6761**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including

After Final communications labeled

"Box AF"]

(703) 746-7418 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

Jeffrey A. Smith
Primary Examiner